

**REMARKS**

This is in response to the Office Action mailed on October 26, 2004, and the references cited therewith.

The Examiner and Applicant's Representative, Barbara Clark, held a telephonic interview on January 25, 2005. Applicant's Representative, John O'Toole also participated in the interview. Specification language, proposed claim amendments and the Francis reference were discussed. The Examiner indicated that the proposed amendments were likely acceptable, although a new search would be performed. Ms. Clark thanks the Examiner for the courtesies extended during the interview.

Claims 1, 15, 32, 37-38, 43 and 45 are amended, claims 2-3, 18-20, 23, 25-26, 30-31, 36, 40, 44, 58 and 66-76 remain canceled, and claims 77-79 are added; as a result, claims 1, 4-17, 21-22, 24, 27-29, 32-35, 37-39, 41-43, 45-57, 59-65 and 77-79 are now pending in this application.

The amendments made herein have been to clarify the claims and to correct typographical errors and are not intended to limit the scope of equivalents to which any claim element may be entitled. The amendments to the claims and new claims have support throughout the specification, including on pages 15 and 17. No new matter has been added as a result. Applicant respectfully requests reconsideration of the above-identified application in view of the amendments above and the remarks that follow.

**Claim Objections**

Claims 35, 37 and 38 were objected under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant has amended claims 1, 37 and 38. Withdrawal of the rejection is respectfully requested.

Claim 45 was objected to because it depended from canceled claim 44.

Applicant has now amended claim 45 to depend from claim 43. Withdrawal of the rejection is respectfully requested.

§112 Rejection of the Claims

Claims 1, 4-17, 21, 22, 24, 27-29, 32-35, 37-39, 41-43, 45-57, 59-65 were rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is believed that the amendments made herein to claims 1, 15, 34, 38, 43 and 45 obviate these objections.

Reconsideration and withdrawal of the rejections are respectfully requested.

§103 Rejection of the ClaimsClaims 1, 9, 10, 12, 15, 16, 41, 43, 59-61

Claims 1, 9, 10, 12, 15, 16, 41, 43, 59-61 were rejected under 35 USC § 103(a) as being unpatentable over Sirohi et al. (U.S. Patent No. 6,773,734 B2) in view of Francis and Lusas et al. (U.S. Patent No. 5,296,253).

The Office Action asserts that Sirohi teaches a food bar of any shape with a water activity of 0.2-0.4 that is sealed in a package with a moisture barrier and oxygen barrier. The Office Action admits that Sirohi does not teach the package is a vacuum sealed laminate having less than 1 ppm hexanal and that the food has a crush resistance of greater than 7 psi, but relies on Francis for evidence of a particular crush resistance and Lucas for 1 ppm hexanal and a vacuum-sealed laminate bag.

Applicant respectfully submits that the Office Action has not established the *prima facie* obviousness of the present claims. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP 2142 (citing In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir.1991)).

Furthermore, claims 9, 10, 12, 15, 16, 41, 43 and 59-61 are dependent claims. The additional limitations provided in dependent claims cannot by themselves be rendered obvious over the cited references if the independent claim from which it depends is determined to be nonobvious.

Sirohi does not teach or suggest the claimed invention. Sirohi discusses a process for making a non-frangible food bar which is not in a vacuum-sealed package. Neither Francis nor Lucas overcome the deficiencies of the primary reference. Francis discusses the crush resistance of both frangible and non-frangible products in relation to moisture content. There is no teaching or suggestion in Francis of the relation between crush resistance and vacuum packaging. Lusas discusses an intermediate moisture legume and cereal food product and method of producing. Rather than individual food pieces as in Francis, the product in Lusas is a cereal bar.

Clearly, the methods and products in the primary reference and the methods and products in the secondary references are fundamentally different from each other and such critical differences must be recognized. In re Bond, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990).

There is further no indication in any of the references of any appreciation of the problem being solved by Applicant's invention which includes providing a bag which becomes sufficiently rigid when vacuum-sealed to reduce breakage of an item contained therein, the item comprising a frangible puffed cereal-based material having a crush resistance or resistance to compression no less than about 7.0 PSIA, as recited in claim 1, as amended. Since none of the references recognize the problem solved in the present invention, none can suggest its solution. See MPEP 2141.01(a).

Furthermore, there is simply no suggestion in Sirhoi *as to the desirability* of providing a vacuum seal as the Office Action suggests. The mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. Motivation to combine the references must come from within the references themselves and cannot be generated by "hindsight or reconstruction." In this instance, there is simply no suggestion or motivation, either in the cited references themselves or in the knowledge generally available to an art worker, to combine the reference teachings as suggested. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5

USPQ2d 1434 (Fed. Cir. 1988). Applicant requests the Examiner to either provide evidence of such motivation or withdraw this rejection.

An additional requirement of the *prima facie* case is that the *references must teach or suggest all the claim limitations*. Since all of the elements of the claims are not found in the references, Applicant assumes the Examiner is taking official notice of the missing elements from an undisclosed source. For example, the references do not teach a package wherein vacuum-sealing allows the package to be filled with approximately 20 to 60% more cereal-based material. Applicant respectfully objects to the taking of official notice, and pursuant to MPEP 2144.03, Applicant traverses the assertion of official notice and requests that the Examiner cite a reference that teaches the missing element. If the Examiner cannot cite a reference that teaches the missing elements, Applicant respectfully requests that the Examiner provide an affidavit that describes how the missing element is present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicant requests withdrawal of the rejection and reconsideration and allowance of the claims.

Yet another requirement of the *prima facie* case is that there must be a *reasonable expectation of success*. In this instance, there would be no reasonable expectation of success without the benefit of Applicant's disclosure. The fact that breakage of a frangible puffed cereal-based material having a crush resistance or resistance to compression of at least 7.0 PSIA is reduced under vacuum is quite surprising and is an unexpected result. Unexpected results must be taken fully into account, pursuant to the congressional mandate for consideration of the invention as a whole. Ex parte Leonard and Brandes, 187 USPQ 122, 123 (PTO Bd. App. 1974). Applicant again asserts that none of the references cited herein or cited previously discuss providing a bag which becomes sufficiently rigid when vacuum-sealed to reduce breakage of an item contained therein, the item having a crush resistance or resistance to compression of at least 7.0 PSIA as recited in the claims.

Applicant has discovered that frangible puffed cereal-based material having a crush resistance or resistance to compression of at least 7.0 PSIA is unexpectedly less prone to breakage when vacuum-sealed. Independent claim 1 recites this as well as certain specific features which characterize the package (e.g., 20 to 60% more cereal-

based material held in package). Claims 9, 10, 12, 15, 16, 41, 43, 59-61 depend from claim 1.

Applicant respectfully submits that the claims are patentably distinct from the cited references, either alone or in combination. Claims 1, 9, 10, 12, 15, 16, 41, 43, 59-61, each viewed as a whole, are not suggested by the cited references and not obvious under 35 USC §103(a).

Reconsideration and withdrawal of the rejection to claims 1, 9, 10, 12, 15, 16, 41, 43, 59-61 under 35 USC §103(a) are respectfully requested.

**Claims 5-8 and 13-14**

Claims 5-8, 13-14 were rejected under 35 USC § 103(a) as being unpatentable over Sirohi et al. in view of Francis and Lusas et al. as applied to claims 1, 9-10, 12, 15, 16, 41, 43, 59-61 above, further in view of Witkowski (U.S. Patent No. 6,594,927 B2). This rejection is respectfully traversed.

Applicant respectfully submits that claims 5-8 and 13-14 are allowable because they depend indirectly on amended independent claim 1 which Applicant submits is allowable for the reasons stated above. If an independent claim is allowable, then any claim depending there from is allowable. Claims 5-8 and 13-14 are further allowable because Witkowski does not cure the deficiencies discussed above with respect to the combination of Sirohi in view of Francis and Lusais.

Reconsideration and withdrawal of the rejection to claims 5-8 and 13-14 under 35 USC §103(a) are respectfully requested.

**Claim 39**

Claim 39 was rejected under 35 USC § 103(a) as being unpatentable over Sirohi et al. in view of Francis and Lusas et al. as applied to claims 1, 9-10, 12, 15, 16, 41, 43, 59-61 above further in view of Hellweg et al. (U.S. Patent No. 5,523,109). This rejection is respectfully traversed.

Applicant respectfully submits that claim 39 is allowable because it depends indirectly on amended independent claim 1 which Applicant submits is allowable for the reasons stated above.

If an independent claim is allowable, then any claim depending there from is allowable. Claim 39 is further allowable because Hellweg does not cure the deficiencies discussed above with respect to the combination of Sirohi in view of Francis and Lusas.

Reconsideration and withdrawal of the rejection to claim 39 under 35 USC §103(a) are respectfully requested.

Claims 1, 10, 16, 22, 27-29, 32, 43, 46, 47, 51-54, 59-61

Claims 1, 10, 16, 22, 27-29, 32, 43, 46, 47, 51-54, 59-61 were rejected under 35 USC § 103(a) as being unpatentable over Gausman (U.S. Patent No. 2,956,383) in view of Francis and Kraft Foods Inc. (WO9812110).

Gausman discusses product settling attachments for packaging machines. Again, Francis discusses the crush resistance of both frangible and non-frangible products in relation to moisture content. Kraft describes a complex apparatus and method for forming sealed packages at high speeds. The process requires formation of temporary seals in the package. The sealed packages hold a comminuted or other flowable product, which is not frangible, such as roasted and ground coffee and rice pieces, such as rice grains or flakes. Applicant can not find any mention in Kraft of packaging containing frangible products.

The Office Action asserted combination of Gausman, Francis and Kraft fails to teach or suggest all of the claim limitations present in independent claim 1, as amended, so a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness under 35 USC 103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim.

For example, one of the limitations of claim 1, as amended, that the combination of Gausman, Francis and Kraft fails to disclose is a bag which becomes sufficiently rigid when vacuum-sealed to reduce breakage of an item contained therein, the item comprising a frangible puffed cereal-based material having a crush resistance or resistance to compression no less than about 7.0 PSIA. This combination also fails to disclose a package wherein vacuum-sealing allows the package to be filled with approximately 20 to 60% more cereal-based material.

Applicant respectfully submits that the claims are patentably distinct from the cited references, either alone or in combination. Claims 1, 10, 16, 22, 27-29, 32, 43, 46, 47, 51-54, 59-

61, each viewed as a whole, are not suggested by the cited references and not obvious under 35 USC §103(a).

Reconsideration and withdrawal of the rejection to claims 1, 10, 13, 15, 16, 27, 28, 41-43, 46-47, 51-54, 59-61 under 35 USC §103(a) are respectfully requested.

Claims 1, 10, 13, 15, 16, 27, 28, 41-43, 46-47, 51-61, 65

Claims 1, 10, 13, 15, 16, 27, 28, 41-43, 46-47, 51-61, 65 were rejected under 35 USC § 103(a) as being unpatentable over Ringe (U.S. Patent No. 5,024,996) in view of Francis and Beer (U.S. Patent No. 6,213,645 B1). This rejection is respectfully traversed.

Applicant respectfully submits that Ringe (U.S. 5,024,996) is not prior art with respect to the present application. A reference asserted under 102(e) that was commonly owned with an application at the time the invention was made, cannot preclude patentability under 35 U.S.C. 103 of the claims of the application when the application was filed on or after November 29, 1999. *35 U.S.C. 103(c); 1233 OG 55 (April 11, 2000)*. The present application was filed on August 31, 2001, which is after November 29, 1999. Ringe and the present application were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. A copy of the assignment executed on August 27, 2001 for the subject application is included herewith. Thus, Ringe is commonly owned with the present application and is not prior art with respect to the present application.

The remaining references alone fail to disclose or render obvious all elements of Applicant's claims 1, 10, 13, 15, 16, 27, 28, 41-43, 46-47, 51-61, 65 for all the reasons stated above and in previous arguments.

Reconsideration and withdrawal of the rejection to claims 1, 10, 13, 15, 16, 27, 28, 41-43, 46-47, 51-61, 65 under 35 USC §103(a) are respectfully requested.

Claims 9, 11, 33, 34

Claims 9, 11, 33, 34 were rejected under 35 USC § 103(a) as being unpatentable over Ringe in view of Francis and Beer (U.S. Patent No. 6,213,645 B1) as applied to claims 1, 10, 13, 15, 16, 27, 28, 41-43, 46, 47, 51-61, 65 further in view of Galomb (U.S. Patent No. 6,245,367 B1). This rejection is respectfully traversed.

Ringe is not prior art with respect to the present application for the reasons stated above. The remaining references alone fail to disclose or render obvious all elements of Applicant's claims.

Furthermore, Applicant respectfully submits that claims 9, 11, 33 and 34 are allowable because they depend indirectly on amended independent claim 1 which Applicant submits is allowable for all the reasons stated above. If an independent claim is allowable, then any claim depending there from is allowable.

Reconsideration and withdrawal of the rejection to claims 9, 11, 33 and 34 under 35 USC §103(a) are respectfully requested.

**Claims 4 and 48**

Claims 4 and 48 were rejected under 35 USC § 103(a) as being unpatentable over Ringe in view of Francis and Beer as applied to claims 1, 10, 13, 15, 16, 27, 28, 41-43, 46, 47, 51-61, 65, further in view of Ray (U.S. Patent No. 2,370,419). This rejection is respectfully traversed.

Ringe is not prior art with respect to the present application for the reasons stated above. The remaining references alone fail to disclose or render obvious all elements of Applicant's claims.

Furthermore, Applicant respectfully submits that claims 4 and 48 are allowable because they depend indirectly on amended independent claim 1 which Applicant submits is allowable for the reasons stated above. If an independent claim is allowable, then any claim depending there from is allowable.

Reconsideration and withdrawal of the rejection to claims 4 and 48 under 35 USC §103(a) are respectfully requested.

**Claims 49 and 50**

Claims 49 and 50 were rejected under 35 USC § 103(a) as being unpatentable over Ringe in view of Francis and Beer further in view of Ray as applied to claims 4 and 48 above, further in view of Ours et al. (U.S. Patent No. 6,062,467). This rejection is respectfully traversed.

Ringe is not prior art with respect to the present application for the reasons stated above. The remaining references alone fail to disclose or render obvious all elements of Applicant's claims.

Furthermore, Applicant respectfully submits that claims 49 and 50 are allowable because they depend indirectly on amended independent claim 1 which Applicant submits is allowable for the reasons stated above. If an independent claim is allowable, then any claim depending there from is allowable.

Reconsideration and withdrawal of the rejection to claims 49 and 50 under 35 USC §103(a) are respectfully requested.

*Claim 17*

Claim 17 was rejected under 35 USC § 103(a) as being unpatentable over Ringe in view of Francis and Beer as applied to claims 1, 10, 13, 15, 16, 27, 28, 41-43, 46, 47, 51-61, 65 further in view of Bendenk et al. (U.S. Patent No. 3,753,728). This rejection is respectfully traversed.

Ringe is not prior art with respect to the present application for the reasons stated above. The remaining references alone fail to disclose or render obvious all elements of Applicant's claims.

Furthermore, Applicant respectfully submits that claim 17 is allowable because it depends indirectly on amended independent claim 1 which applicant submits is allowable for the reasons stated above. If an independent claim is allowable, then any claim depending there from is allowable.

Reconsideration and withdrawal of the rejection to claim 17 under 35 USC §103(a) are respectfully requested.

*Claim 24*

Claim 24 was rejected under 35 USC § 103(a) as being unpatentable over Ringe in view of Francis and Beer as applied to claims 1, 10, 13, 15, 16, 27, 28, 41-43, 46, 47, 51-61, 65 further in view of Schwab et al. (U.S. Patent No. 5,342,635). This rejection is respectfully traversed.

Ringé is not prior art with respect to the present application for the reasons stated above. The remaining references alone fail to disclose or render obvious all elements of Applicant's claims.

Furthermore, Applicant respectfully submits that claim 24 is allowable because it depends indirectly on amended independent claim 1 which Applicant submits is allowable for the reasons stated above. If an independent claim is allowable, then any claim depending there from is allowable.

Reconsideration and withdrawal of the rejection to claim 24 under 35 USC §103(a) are respectfully requested.

Claims 21 and 22

Claims 21 and 22 was rejected under 35 USC § 103(a) as being unpatentable over Ringé in view of Francis and Beer as applied to claims 1, 10, 13, 15, 16, 27, 28, 41-43, 46, 47, 51-61, 65, further in view of Bendenk et al. This rejection is respectfully traversed.

Ringé is not prior art with respect to the present application for the reasons stated above. The remaining references alone fail to disclose or render obvious all elements of Applicant's claims.

Furthermore, Applicant respectfully submits that claims 21 and 22 are allowable because they depend indirectly on amended independent claim 1 which Applicant submits is allowable for the reasons stated above. If an independent claim is allowable, then any claim depending there from is allowable.

Reconsideration and withdrawal of the rejection to claims 21 and 22 under 35 USC §103(a) are respectfully requested.

Claims 62-64

Claims 62-64 was rejected under 35 USC § 103(a) as being unpatentable over Ringé in view of Francis and Beer as applied to claims 1, 10, 13, 15, 16, 27, 28, 41-43, 46, 47, 51-61, 65 further in view of Miyake et al. (U.S. Patent No. 5,942,320). This rejection is respectfully traversed.

Ringe is not prior art with respect to the present application for the reasons stated above. The remaining references alone fail to disclose or render obvious all elements of Applicant's claims.

Furthermore, Applicant respectfully submits that claims 62-64 are allowable because they depend indirectly on amended independent claim 1 which Applicant submits is allowable for the reasons stated above. If an independent claim is allowable, then any claim depending there from is allowable.

Reconsideration and withdrawal of the rejection to claims 62-64 under 35 USC §103(a) are respectfully requested.



AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111  
Serial Number: 09/945,318  
Filing Date: August 31, 2001  
Title: VACUUM-SEALED PACKAGE CONTAINING FRANGIBLE MATERIALS (AS AMENDED)

Page 22  
Dkt: 869.021US1

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 515-233-3865 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

WAYNE I. KNIGGE ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
515-233-3865

Date JANUARY 26, 2005

By Barbara J. Clark  
Barbara J. Clark  
Reg. No. 38,107

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 26 day of January, 2005.

Name

Gina M. Uphus

Signature

Gina M. Uphus